

REMARKS/ARGUMENTS

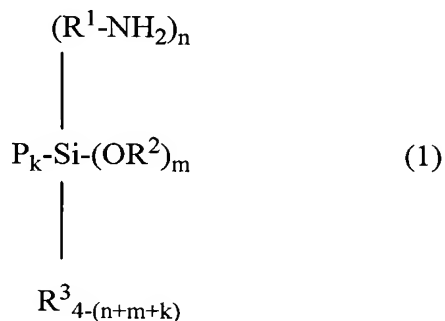
Applicants' representative would like to thank Examiner Lenihan for the courteous and helpful discussion of the issues in the present application on April 20, 2010. The above amendments and following remarks summarize and fully expand on the content of that discussion.

Claims 1 and 3-5 are active in this application, claim 2 having been previously canceled. Claim 1 has been amended to specify that component (I) is present in an amount of 1-10 % by weight, and component (II) is present in an amount of 90-99% by weight. Additionally, component (I) is amended to require a weight average molecular weight of 1000 to 70,000. This is supported by the specification at page 30, lines 11-12. The percentage ranges are supported by the Examples in the present application. Additionally, Claim 1 has been amended to specify that P is a copolymer chain of conjugated diene and aromatic vinyl compound, which excludes the case where only conjugated diene units are present. No new matter has been added by these amendments.

The present invention relates to a rubber composition comprising

(I) 1 to 10% by weight of a conjugated diene-based (co)polymer rubber represented by the following formula (1) having an amino group and an alkoxysilyl group on a polymer chain and having a weight average molecular weight of 1,000 to 70,000, and

(II) 99 to 90% by weight of a conjugated diene-based (co)polymer rubber having a weight average molecular weight of 100,000 to 2,000,000 (with the proviso that (I)+(II)=100% by weight),



wherein P is a (co)polymer chain comprising a conjugated diene and an aromatic vinyl compound, R¹ is an alkylene group having 1 to 12 carbon atoms, R² and R³ are each independently an alkyl group having 1 to 20 carbon atoms or an aryl group, n is an integer of 1 or 2, m is an integer of 1 or 2, and k is an integer of 1 or 2, with the proviso that n+m+k is an integer of 3 or 4.

The claims stand rejected under 35 U.S.C. § 103 over Kobayashi et al. J.P. '936, in view of Kobayashi et al. (based upon its equivalent Tsukimawashi et al. U.S. Publication 2004/0254301). The Examiner has combined the references to suggest that it would be obvious for one of ordinary skill to use the copolymer of formula (1) of Tsukimawashi et al for the copolymer (b) of Kobayashi JP '936 in order to arrive at the present invention. However, Applicants note that the copolymer of formula (1) of Tsukimawashi and the copolymer (b) of Kobayashi JP '936 are of significantly different chemical structures. Thus one of ordinary skill would not be motivated to substitute one for the other.

Even if one were to accept the Examiner's suggestion that Kobayashi et al. and Tsukimawashi et al. can be combined to render the present invention obvious there is nothing within either reference to suggest the specific combination of the two (co)polymer rubbers as required in the present invention, wherein the first of the two (co)polymer rubbers has formula (1), is present in an amount of 1-10% by weight and has a molecular weight of 1000 to 70,000 as required in the present invention. In fact, the weight average molecular weight of the copolymer represented by formula (2) of Tsukimawashi is reported to be 100,000 to

2,000,000 (preferably 150,000 to 1,700,000; see paragraph [0181]), and the weight average molecular weight of the copolymer (b) of Kobayashi is reported to be 90,000 to 2,000,000. Thus, neither of these could suggest the present invention wherein the copolymer of formula (1) has a molecular weight of from 1,000 to 70,000. Accordingly, even if one were to combine the teachings of the two references, the resulting composition would NOT be the present invention, as the component corresponding to copolymer (1) of the present invention would have a molecular weight that is significantly too high. Thus, the references cannot combine to render the present invention obvious and the rejection should be withdrawn.

Additionally, Applicants have previously discussed the data within the present specification showing a surprising or unexpected improvement using the present invention. Since the claims are of commensurate scope with the data presented, Applicants submit that even if the Examiner were to still maintain that the references could be combined to render the invention obvious, these data amply rebut that position. Accordingly, the rejections should be withdrawn.

Applicants submit that the application is in condition for allowance and early notification of such action is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, L.L.P.
Norman F. Oblon



J. Derek Mason
Attorney of Record
Registration No. 35,270

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 07/09)